

REMARKS

Claims 1-4 are pending in the application. Claim 4 has been amended, leaving claims 1-4 for consideration upon entry of the present Amendment. Applicant requests reconsideration in view of the Amendment and Remarks submitted herewith.

Claim 4 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Trihn et al. (US 6,392,861) ("Trihn"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 4 includes the following limitations: "a clear hole to which a lead line of said surge absorber element is inserted, said lead line is connected with an electrode within a housing; and a binding section provided around said clear hole for snapping onto said lead line." Trihn does not teach or suggest that limitation.

Instead, Trinh discloses a mounting cap that has an end (40), which is in electrical contact with the surge arresting elements (30) and (24). See Figure 1. Thus, Trinh teaches that the mounting cap is an electrode itself. Accordingly, Trinh does not teach or suggest having a clear hole in which a lead line is inserted or that the lead line is connected with an electrode within a housing. Moreover, although the Examiner states that the clear hole (46) connects the lead line and snaps it with the binding section provided around the hole, the caps (20) and (22) have no section for binding the lead lines. Instead, the resistor (64) is inserted between the second end (42) and the second connector (18). There is no connection between the second end (42) and the lead line. See column 4, line 54 to column 5, line 5. See also Figures 1 and 2.

Accordingly, Trihn does not anticipate claim 4. Applicant respectfully requests that the Examiner withdraw this rejection.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boy et al. (US 5,633,777) ("Boy") in view of Trihn. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of

success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996). In this case, the Examiner has not met the burden of establishing that all elements of the invention are disclosed in the prior art.

Claims 1-3 include the following limitation: “a surge absorber element, constructed by affixing discharge electrodes with lead lines on both internal ends of a cylindrical housing, and having a chamber gap within the housing between said discharge electrodes adjusted by the fixed positions of said discharge electrodes so that desired discharge characteristics are obtained; and * * * a binding section provided around said clear hole for snapping onto said lead line.” Boy and Trihn do not teach or suggest these limitations.

The Examiner states that Boy discloses a surge absorber comprising a surge absorber element constructed by discharge electrodes (20) and surface mounting caps (17); however, number 20 in Boy is the varistor, not the electrode. See column 4, line 49. The electrode in Boy is labeled as number 1 or 3. Furthermore, the varistor (17) is not connected to the electrode (1) because the varistor is to provide a variable capacitance to the surge absorber. Moreover, Boy does not disclose a lead line for making a contact between the electrode and outer electrical circuit. Instead, the electrode (1) is connected to connecting wire through the contact ring 13 as indicated in column 4, lines 37 to 45.

In addition, as the Examiner acknowledges Boy does not disclose that the surface mounting cap comprises a clear hole and a binding section. The Examiner asserts that Trihn discloses a surge arrester with a mounting cap comprising a flange section and a clear hole to which a lead line is connected and a binding section is provided around the clear hole for snapping into the lead line. Applicant respectfully traverses.

Trinh discloses a mounting cap that has an end (40), which is in electrical contact with the surge arresting elements (30) and (24). See Figure 1. Thus, Trinh teaches that the mounting cap is an electrode itself. Accordingly, Trinh does not teach or suggest having a clear hole in which a lead line is inserted or that the lead line is connected with an electrode within a cylindrical housing. Moreover, although the Examiner states that the clear hole (46) connects the lead line and snaps it with the binding section provided around the hole, the caps (20) and (22) have no section for binding the lead lines. Instead, the resistor (64) is inserted between the second end (42) and the second connector (18). There is no connection between the second end (42) and the lead line. See column 4, line 54 to column 5, line 5. See also Figures 1 and 2.

Accordingly, Boy and Trihn, either alone or in combination, do not teach or suggest the following limitations: "a surge absorber element, constructed by affixing discharge electrodes with lead lines on both internal ends of a cylindrical housing, and having a chamber gap within the housing between said discharge electrodes adjusted by the fixed positions of said discharge electrodes so that desired discharge characteristics are obtained; and * * * a binding section provided around said clear hole for snapping onto said lead line." Applicant respectfully requests that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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